



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,393	10/26/2001	Joel S. Hochman	Athena1	9804
30996	7590	06/04/2004		EXAMINER
ROBERT W. BECKER & ASSOCIATES 707 HIGHWAY 66 EAST SUITE B TIJERAS, NM 87059				MARMOR II, CHARLES ALAN
			ART UNIT	PAPER NUMBER
				3736

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/007,393	HOCHMAN ET AL. <i>CH</i>
	Examiner Charles A. Marmor, II	Art Unit 3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 11-15 is/are rejected.
- 7) Claim(s) 8-10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. This Office Action is responsive to the Amendment and Request for Reconsideration in response to the Office Action dated February 17, 2004 filed April 23, 2004. The Examiner acknowledges the amendments to claims 7 and 9. Claims 1-15 are pending.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Objections

3. Claim 7 is objected to because of the following informalities: in line 3, "and;" apparently should read --; and--. Appropriate correction is required.
4. Claim 9 is objected to because of the following informalities: in line 3, "stimulationand" apparently should read --stimulation and--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The rejection of Claim 9 under 35 U.S.C. 112, first paragraph, set forth in the Office Action mailed February 17, 2004 has been withdrawn in view of the amendment filed April 23, 2004.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7 and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Guice et al. ('390). Guice et al. teach a system and method for monitoring the health and status of livestock and other animals. The system includes at least a single, separate unit **50,51,280** in the form of a portable, intravaginally containable combination probe, transceiver and power source and a single, separate unit **70,72** in the form of a combination controller and transceiver. The use of the transitional term “comprising” in the claim language is inclusive or open-ended and does not exclude additional, unrecited elements (i.e., in addition to the claimed two “single, separate units”) and method steps. See MPEP 2111.03. The single, separate unit **50,51,280** in the form of a portable, intravaginally containable combination probe, transceiver (see at least paragraph [0124]) and power source **288** is “non-implanted” in the same sense as the limitation is defined in the specification of the instant application (i.e., “intravaginally containable... in situ yet removable” as recited in paragraph [0010]), although the patentee has chosen to call his telesensor an “implant.” The Guice implant embodiments of Figs. 18 and 19 (see paragraph [0179]) are in the form of spring-like curved members that can be compressed to a smaller diameter to be inserted into a vaginal cavity, then expand to a larger diameter after being inserted into the vaginal cavity, and are provided with tabs **299** or a wire member **301** to aid in removal of

the telesensor implant without the need for incisions or surgery. The combination probe, transceiver and power source is provided with means for sensing vaginal conditions **292** and 2-way wireless communication means for transmitting information that is transduced and for receiving control and programming signals (see at least paragraph [0124]). The separate combination controller and transceiver is provided with wireless means for sending signals to the probe and for receiving signals therefrom (see at least paragraph [0209]). A wireless signal feedback loop is provided between the controller and the probe and which may be an interactive or closed signal feedback wireless loop. The probe is a sealed unit which is inserted "in-situ" into the vaginal vault or removed therefrom (see at least paragraph [0135]). The means for sensing vaginal conditions of the probe include sensor transducers **292** that may be provided with means for transducing in the form of a muscle activity sensor (see at least paragraph [0080]); means for sampling temperature changes (see at least paragraph [0106]) in the vaginal environment. The wireless combination controller and transceiver includes means for wirelessly altering operation settings of the probe and means for wirelessly altering the transducing sensor (see at least paragraph [0104]). A wireless means **72** is provided to transmit signals to and/or receive signals from external devices, networks, or databases. The controller may be a hand-held unit (e.g., a PDA).

Allowable Subject Matter

8. Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

No prior art of record teach or fairly suggest a system, as claimed by Applicant, where the single, separate unit in the form of an intravaginally containable combination probe, transceiver and power source is provided with at least one of means for delivering medication to the vaginal vault and means for stimulating perineal musculature and nerves in combination with means for sensing or transducing vaginal conditions.

Response to Arguments

10. Applicant's arguments, see pages 6-17 in the Request for Reconsideration filed April 23, 2004, with respect to the rejection of claims 1-15 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn and the finality of the last Office action is withdrawn as stated hereinabove. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretation of a previously cited reference. U.S. Patent Application Publication No. 2002/0010390 (Guice et al.), discussed hereinabove, teach a system and method for transducing vaginal conditions including a single, separate unit in the form of a portable, non-implanted, intravaginally containable combination probe, transceiver and power source that is provided with means for sensing vaginal conditions and 2-way wireless communication means; and a single, separate unit in the form of a combination controller and transceiver that is provided with wireless means for sending signals to the probe and for receiving signals therefrom; where a wireless signal feedback loop is provided between the controller and the probe.

Conclusion

11. Applicant's amendment filed December 8, 2003 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on (703) 308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

cam
May 26, 2004